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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,569	02/01/2002	Gordon Ko	5981	2762

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EXAMINER

ENGLE, PATRICIA LYNN

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 12/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,569

Applicant(s)

KO, GORDON

Examiner

Patricia L Engle

Art Unit

3612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-17 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 10 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The term "simplified" in claims 1, 11 and 19 is a relative term which renders the claim indefinite. The term "simplified" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. How is simplified defined? What makes the shields simplified to handle roll and store?

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-9, 11-17, 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spears (US Patent 4,810,013) in view of McNeil (US Patent 4,810,015) and Huard (US Patent 4,974,892).

Spears discloses a removably attachable shielding to protect vehicle side surfaces and doors to prevent dents and scratches imposed by doors of adjacent vehicles, said shielding comprising: two shield pads (11a,11b) of impact absorbing material, at least one strap (19,21,23) secured to a lateral edge portion (43) of each of said shield pads (11a,11b) to connect them together, an elastic strap (27) having an end thereof secured to an edge portion (45) of a first one (11a) of the shield pads, and fastener means (57) for detachably securing a second end portion (25) of the elastic strap (27) to a second one of the shield pads. Regarding claim 2, Spears discloses that the shield pads (11a,11b) are sized and configured to cover a principal area of a vehicle's side surfaces and doors (29). Regarding claims 3 and 11, Spears discloses that the two spaced apart straps extend between and are secured to lateral edge portions (43) of the two shield pads (11a,11b).

Spears does not disclose the suction cups are used to attach the pads to the vehicle or that the pads are rolled up together.

Huard discloses a shield pad for a vehicle which is attached to the vehicle by a suction cup. Regarding claims 4 and 12, Huard discloses two spaced apart suction cups to attach the shield to the door in Figure 3.

Huard and Spears are analogous art because they are from the same field of endeavor, i.e., protective pads for vehicle sides and vehicle doors.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to mount the shield pads with suction cups.

The motivation would have been to prevent the shield pads from moving around on the vehicle side when installed.

McNeil discloses a shield pad for a vehicle side door which is made of a material which can be rolled.

McNeil and Spears are analogous art because they are from the same field of endeavor, i.e., protective pads for vehicle sides and vehicle doors.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to make the pad of a material which is capable of being rolled as it would merely involve the alternate utilization of an equivalent material to achieve the same exact function of protecting the vehicle.

Therefore, it would have been obvious to combine McNeil and Huard with Spears to obtain the invention as specified in claim 1, 2, 3, 4, 11, 12.

Regarding claims 5, 7, 13, 15 and 19, Spears as modified does not disclose that the elastic strap is connected to an edge portion of one of the shield pads. However, it would have been obvious to one of ordinary skill in the art to allow the elastic strap to be joined to one of the shield pads to hold the shield pads in the compact position, as taught by an umbrella.

Regarding claims 6 and 14, Spears does not disclose that the two spaced apart straps are secured to an edge portion of the shield by riveting. McNeil discloses that it is known to attach straps to edge portions of shields by riveting (column 2, lines 65-66). It would have been obvious to one of ordinary skill in the art at the time of the invention

Art Unit: 3612

to connect the straps to the shield pads by rivets as taught by McNeil. The motivation would have been to simplify the connection of the straps and the shields.

Regarding claims 8, 9, 16, 17, 20, 21, 23 and 24, Spears does not disclose that the shield pads are made from a blend of neoprene rubber, ethylene propylene, styrene butadiene rubber or ethylene vinyl acetate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use these materials, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of mechanical expedient.

Double Patenting

6. Claim 19 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 7. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Allowable Subject Matter

7. Claims 10 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed November 25, 2002 have been fully considered but they are not persuasive.

9. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

10. In response to applicant's argument that an umbrella is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, an umbrella is a teaching of a method of holding a rolled item rolled and would be reasonably pertinent to the particular problem of holding a rolled item rolled. Sleeping bags are another example of holding a flexible material in the rolled position with a strap attached to one end of the flexible material.

11. Regarding applicants arguments that the rejection for claims 6 and 14 do not discuss the suction cups. Claims 6 and 14 do not claim suction cups. However, claims 4 and 12 do claim suction cups. As seen in paragraph 5 of this Office Action, Huard discloses the suction cups in Figure 3.

12. Regarding the arguments to claims 8, 9, 16, 17, 20, 21, 23 and 24, all of the materials that the applicant has claimed are known in the art. It would have been

obvious to one of ordinary skill in the art at the time of the invention to select a known material to best suit the application of the product.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L Engle whose telephone number is (703) 306-5777. The examiner can normally be reached on Monday - Friday from 8:00 to 5:00.

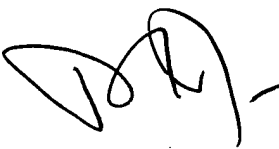
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Glenn Dayoan can be reached on (703) 308-3102. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Art Unit: 3612

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Patricia L Engle
Examiner
Art Unit 3612

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December 16, 2002

 12/17/02
D. GLENN DAYOAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600